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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER L. PARMELEE and MARK D. SMITH

Appeal 2008-002907
Application 09/683,943
Technology Center 2400

Decided:¹ July 1, 2009

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-41. The Appellants appealed therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). On March 19, 2009, we affirmed the rejection of all the claims, and Appellants filed a Request for Rehearing on May 11, 2009.

A. INVENTION

The invention at issue on appeal relates to automated transaction machine digital signature system and method. (Spec. 1.)

II. ISSUE

Have Appellants specifically identified any points misapprehended or overlooked by the Board in its decision?

III. ANALYSIS

In the Request for Rehearing, Appellants advance that dependent claim 5 is an exemplary indication of points which were misapprehended or overlooked by the Board in our decision. At the outset, we note that arguments to a dependent claim do not clearly show any other points misapprehended or overlooked by the Board in our decision.

Appellants' Request for Rehearing generally addresses the same contention as advanced in the Brief and Reply Brief. That contention is that the Wheeler provisional application does not provide adequate support for the Wheeler published application to establish the earlier domestic priority

date for the Wheeler published application. While we agree with Appellants that the totality of the subject matter in the Wheeler published application is more polished and goes into greater depth and detail than the subject matter taught in the Wheeler provisional application, the Examiner did not rely upon the totality of the Wheeler published application to evidence these specific features which were known in the art at the time Appellants' invention was made. The Examiner limited the specific factual findings which were relied upon in the rejection and provided evidence to support that those specific factual findings, in the Wheeler published application, were known in the art at the time of the Wheeler provisional application, prior to Appellants filing date. After the Board's reasoned analysis of the totality of the Wheeler provisional application, we found "ample support for those portions of the Wheeler published application which were relied upon in the rejection to entitle those portions of the published application to the filing date of the provisional application." (Decision 6, ll. 11-14).

Appellants contend that this finding is not supported in the decision or in any other part of the record. (Request 2). As in the Brief and Reply Brief, Appellants provide no evidence or reasoned analysis with specific findings/citations and conclusions with which to support this contention.

Appellants advance a number of arguments based on form rather than substance. For example, the Appellants contend that the four e-mail communications in the Wheeler provisional application are "significantly dissimilar to the organization and content of the subject matter in the Wheeler publication." (Request 2). As acknowledged above, the form of the disclosure does not indicate a lack of support. Moreover, additional content in the published application does not necessarily support Appellants'

contention that the specific portions relied upon by the Examiner in the rejection are not supported by the Wheeler provisional application.

Appellants further contend that the Board based its decision on improper hindsight since Appellants contend that the subject matter relied upon in the Examiner's rejection is not supported by the provisional application. (Request 2). We disagree with Appellants' contention since we find the Examiner's reliance in the Wheeler published application to be supported by the Wheeler provisional application.

With respect to our reliance upon *Ex parte Yamaguchi* in our decision at page 15, Appellants contend that the Wheeler provisional application is a set of unconnected e-mails that do not clearly show all of the subject matter as the Wheeler publication. (Request 3). Again, Appellants' contention appears to go beyond the limited subject matter portions which the Examiner relied upon in the Wheeler published application in the grounds of the rejection. Appellants further contend that "the portions of the Wheeler Publication relied upon by the Board in its decision include significant amounts of non-prior art new matter not found in the Wheeler Provisional," but Appellants do not specifically identify these "significant amounts of non-prior art new matter." Therefore, we find that Appellants' argument does not specifically identify any points of overlooked or points misapprehended by the Board in our decision.

In accordance with *Ex parte Yamaguchi*,
<http://www.uspto.gov/web/offices/dcom/bpai/prec/fd074412.pdf>, slip op. (BPAI Aug. 29, 2008) (precedential) the Examiner found that the Wheeler provisional application clearly shows the same subject matter as applied from the Wheeler published application used in the prior art rejections. The

Examiner found that both documents clearly show the same subject matter - a factual finding. By making this factual finding, the Examiner then shifted the burden to Appellants to show why such a factual finding was erroneous. While there are differences between the Wheeler published application and its corresponding Wheeler provisional application, the differences are simply not germane to the facts relied upon by the Examiner in the rejection.

Appellants address an exemplary discussion with respect to dependent claim 5, which the Board addressed generally for judicial efficiency in the 41 separate groups of arguments for the 41 claims.

We will address Appellants' arguments to dependent claim 5, but find the arguments to be unpersuasive. In the Brief at page 29, Appellants argue that dependent claim 5 recites that the digital safe-deposit account is associated with a financial account number and that the computer processor is operative to access the private key associated with the one digital safe-deposit account responsive to a message received from the at least one ATM, which message includes a financial account number that corresponds to the account number associated with the one digital safe-deposit account. As discussed in our decision at page 17, we discussed the merits of dependent claim 3 regarding the combination of Wheeler and Cohen to retrieve an electronic document from a data store and send the document to the ATM machine. In the combination of teachings, we find that it would have been obvious to one of ordinary skill in the art at the time of the invention that there would necessarily have to be some identification information/"financial account information" with which to retrieve and forward the appropriate electronic document. With encryption of the

electronic information, access to the key would therefore have also been necessary.

With respect to Appellants' argument concerning the "computer processor," the decision at pages 15-16 addresses the application of the prior art to the teachings concerning the computer processor. Appellants' arguments do not address the merits of this correlation and mapping. Therefore, Appellants' argument does not specifically identify any points overlooked or misapprehended by the Board in the decision. With respect to dependent claim 5, Appellants further reiterate the arguments advanced with respect to independent claim 1, which we found unpersuasive of the error in the Examiner's showing.

Appellants go on to again reiterate their contention that the Wheeler publication does not qualify as prior art. (App. Br. 30). Again, as discussed in the decision with respect to independent claim 1, we find Appellants' argument to be unpersuasive of the error in the Examiner's showing of obviousness. Since our above discussion evidences the content of a discussion of dependent claim 5 to have been already shown in the prior discussions with respect to Appellants' claim invention, the Board summarily dismissed the arguments as unpersuasive in the decision at page 18. Therefore, Appellants have not specifically identified any points overlooked or misapprehended in our decision.

Furthermore, Appellants continued in their arguments to maintain that the Office has not provided any reason or other rationale as to why one of ordinary skill of the art would modify and/or combine the Wheeler "provisional," with Cohen or any other applied art to produce the recited subject matter. (Request 5). As discussed in the decision with respect to the

Reply Brief, it is not the Wheeler provisional application which is applied as prior art, it is the Wheeler published application. Therefore, Appellants' argument is unpersuasive of error.

Rather, the issue is a difference of opinion as to whether the provisional application provides adequate support under 35 U.S.C. § 112, first paragraph, for those portions relied upon in the rejection to evidence that the specific teachings were known by others before the invention thereof by Appellants. We found in the decision that there was "ample support" in the provisional application for those portions. While the form and specific wording used in the provisional application differs from that in the published application, we nonetheless found support that those facts were known in the art prior to the time Appellants filed their application for patent.

Appellants argue that the Office has not established a "clear showing" that the Wheeler provisional supports the subject matter of the Wheeler publication, and that the "text" of the Wheeler provisional and the Wheeler publication are "too dissimilar." (Request 5-6) We disagree with Appellants and note that it is the subject matter as appreciated by one of ordinary skill in the art at time of the invention rather than the form or specific text used which is evaluated to determine whether the provisional application supports those portions of the published application relied upon by the Examiner. Hence, we find that Appellants' arguments with respect to dependent claim 5 do not specifically identify any points overlooked or misapprehended by the Board in its decision.

With respect to claim 20, Appellants argue that although the Wheeler provisional application discusses "viewing what was signed," nowhere does the Wheeler provisional or any of the other applied art teach viewing an

electronic document to be signed on an ATM or any other device from which a financial account number is received. (Request 8). We find Appellants' contention unavailing since the method of independent claim 20 merely sets forth enabling an electronic document displayed by an automated transaction machine to be digitally signed by the private key. If the rejection of claim 20 was based merely upon anticipation, Appellants may have a basis for this argument, but the rejection is based upon obviousness. "Common sense" at least suggests that a document to be digitally signed by a user would have been viewed prior to signing and would have been suggested by a teaching that you can display the document which was signed. We find that the Wheeler publication evidences and suggests viewing prior to the signing since a display device is suggested to be available for viewing after the signing. The Supreme Court considers "common sense" in evaluating prior art teachings.

Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.

(KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 420 (2007)).

The necessary hardware to view before and view after are the same and is present in the prior art. Therefore, it would have been readily apparent to skilled artisans to view before so that the user can make an informed decision on what is being signed.

Furthermore, we find that this is no more than a modification clearly within the ordinary skill of artisans at the time of the invention. Appellants have not identified any difficulty in displaying before or after the signing.

Therefore, Appellants' argument does not show error in the Examiner's showing of obviousness. Nor does Appellants' argument specifically identify any points overlooked or misapprehended by the Board in its decision.

With respect to dependent claim 23, Appellants argue that nowhere has the Office shown prior art of record (i.e., prior art that is not contaminated with the allegedly non-prior art portions of the Wheeler publication) which shows the recited element of storing a digitally signed copy of electronic document in a digital safe-deposit account in association with the financial account number. (Request 8-9). The decision at pages 28-29 addresses the merits of Appellants' argument, and we found that the Wheeler publication disclosed and fairly suggested the storage of some information concerning an account. As identified in the decision, Appellants' claim 23 is generic as to the method recited in parent claim 20 (Dec. 26-27), and we found that the Wheeler publication taught and fairly suggested storage in association with an account identifier. Therefore, Appellants' argument does not show error to Examiner's initial showing of obviousness. Nor does Appellants' argument specifically identify any points overlooked or misapprehended by the Board in its decision.

With respect to Appellants' arguments concerning the Examiner's improper rejections based on the Wheeler provisional application (Request 9), it is the Wheeler published application which is relied upon in the rejection. Therefore, Appellants' argument does not show error to Examiner's in the showing of obviousness. Nor does Appellants' argument specifically identify any points overlooked or misapprehended by the Board in its decision.

Appellants argue that "[t]he fact that the Office has been required to rely on the (non-prior art) Wheeler Publication rather than the Wheeler Provisional in presenting rejections constitutes an admission by the office that the Wheeler provisional does not provide a sufficient written description to support the rejections." (Request 9). We disagree with Appellants wherein the published application is citable prior art under 35 U.S.C. § 102(e) which may have the benefit of the earlier filing date under 35 U.S.C. § 119(e). Therefore, Appellants' argument does not show error in the Examiner's showing of obviousness. Nor does Appellants' argument specifically identify any points overlooked or misapprehended by the Board in its decision.

With respectful of Appellants' arguments concerning the "Office is now prepared to accept and issue patents which have the glaring defects in the disclosure" of the Wheeler provisional (Request 9), we find no relevance of this argument as to whether or not the Wheeler provisional application adequately supports those portions of the Wheeler published application which were relied upon by the Examiner in rejection. Therefore, Appellants' argument does not show error in the Examiner's showing of obviousness. Nor does Appellants' argument specifically identify any points overlooked or misapprehended by the Board in its decision. Since Appellants have not specifically identified any points misapprehended or overlooked by the Board in its decision, we decline to modify our decision.

IV. CONCLUSION

For the aforementioned reasons, we found that the portions of the Wheeler publication are amply supported by the teachings generally recited in the Wheeler provisional application and therefore the Wheeler publication is entitled to the priority date thereof for the relied upon subject matter. Additionally, we found all of Appellants' arguments to be unpersuasive of error in the Examiner's initial showing of obviousness, and Appellants' arguments do not specifically identify any points misapprehended or overlooked by the Board in its decision.

V. ORDER

We grant the request for rehearing to the extent that it was considered, but we decline to modify our decision based upon Appellants' arguments.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REQUEST DENIED

rwk

RALPH E. JOCKE
walker & jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256